

REMARKS

Claims 1-24 are pending in the application. As indicated above, claims 1 and 23 are amended. Support for the amendments to claims 1 and 23 to include the aspect of one embodiment of the second identification portion located directly on top of the first identification portion is found at least in part in Figure 1B and paragraphs [0013 and 0014] of the Specification. Further, support for the amendments to claims 1 and 23 to include the aspect of one embodiment of having at least one further removable portion or coating applied over at least a part of the first and second overlapping identification portions is found at least in part in Figure 1C and the accompanying description and paragraph [0016] of the Specification. These amendments were made to expedite the issuance of a patent and not to overcome prior art. Further, the other amendments to claim 1 were to correct typographical mistakes. Hence, no prosecution history estoppel arises from the amendments to claims 1 and 23. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 1 and 23 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

Further, the drawings are objected to. Claims 1-24 are rejected under 35 U.S.C. §103(a).

Applicant addresses these objections and rejections below.

I. OBJECTIONS TO THE DRAWINGS:

The Examiner has objected to the drawings for allegedly not showing a claimed feature (e.g., hologram). Office Action (2/22/2008), page 2. As understood by Applicant, the Examiner is focusing on claim 19 which claims a holographic image provided on the identification means. The Figures clearly show an identification means which is the feature being claimed. Further, referring to paragraph [0028] of the Specification, the Specification discloses a holographic image or other security means is provided in association with the

identification means. The Specification further states that the clear holographic image and/or other security means are typically provided over the abradable coating and/or third identification portion. As indicated above, the Figures clearly show the identification means. Hence, the Figures do show the feature of the invention specified in the claims. Further, the Specification clearly supports a holographic image provided on the identification means. The aspect of providing a holographic image on the identification means is not essential for a proper understanding of the invention. Hence, the depiction in the Figures of the identification means is sufficient. See 37 C.F.R. §1.83(a). Hence, Applicant kindly requests the Examiner to withdraw the objections to the drawings.

II. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 1-15, 18, 20, 22, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over Downes et al. (U.S. Patent No. 7,004,506) (hereinafter "Downes") in view of Behm et al. (U.S. Patent No. 5,667,250) (hereinafter "Behm"). The Examiner has further rejected claims 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over Downes in view of Behm and in further view of Raymond (WO 99/56270). Further, the Examiner has rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Downes in view of Behm and in further view of Thompson et al. (U.S. Patent Application Publication No. 2002/0130511) (hereinafter "Thompson"). Additionally, the Examiner has rejected claim 21 under 35 U.S.C. §103(a) as being unpatentable over Downes in view of Behm and in further view of Pistro et al. (U.S. Patent No. 5,832,827) (hereinafter "Pistro"). Applicant respectfully traverses these rejections for at least the reasons provided below and respectfully requests the Examiner to reconsider and withdraw these rejections.

A. Claims 1-15, 18, 20, 22, 23 and 24 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Downes in view of Behm.

The present invention has the significant advantage over the prior art, as will be explained in more detail below, that by providing the removable second identification portion or confusion pattern in direct contact with the first identification

portion, this significantly reduces the likelihood of any deciphering or tampering of the first identification portion taking place. In particular, it has been found through rigorous testing undertaken by Applicant, that laboratory techniques used to fraudulently decipher the first identification portion are not possible when the first and second identification portions are in directly adjacent layers. The more layers provided between the first and second identification portions, the easier the device is to tamper with and decipher the first identification portion.

As stated by the Examiner, Downes discloses an identification means including a first identification portion or indicia relating to secure data in the form of one or more images, characters and/or text. However, Downes does not disclose or suggest the following limitations in claim 1 and similarly in claim 23:

the provision of a second identification portion directly on top of the first identification portion to mask the first identification portion until the second identification portion has been removed, the second identification portion also being in the form of one or more images, characters and/or text, the second identification means being provided in overlapping relationship with the first identification portion so that the combination of the first and second identification portions forms a further one or more images, characters and/or text that is different in appearance to the first and second identification portions, the first and second identification portions being undecipherable from the further one or more images, characters and/or text until the second identification portion has been removed, and at least one removable layer applied over at least a part of the first and second overlapping identification portions.

Conventional deciphering techniques used on the lottery ticket in Downes, such as using x-ray, light or lasers, is likely to reveal the indicia or first identification portion since there is no second identification portion or confusion pattern to block the indicia or first identification portion. Amended claim 1 is therefore both novel and inventive over Downes.

With regard to Behm, we have provided an illustration below as to the arrangements of layers of material in the game ticket compared to the arrangement of layers of material in the present invention. The important difference between Behm and the present invention is that in Behm the indicia layer or first identification

portion is separated by a number of other layers from the removable confusion layer or second identification portion. As such, the ticket in Behm can be easily tampered with by applying a knife between the intermediate layers, thereby allowing easy separation of the confusion layer from the indicia. In addition, as mentioned above, the more intermediate layers provided between the confusion layer and the indicia layer, the easy it is to use laboratory techniques to distinguish the confusion pattern from the indicia and to fraudulently decipher the indicia due to a gap being created between the indicia and confusion layers.

In Behm, the following layer arrangement below is provided:

Game information Layer (28)
Removable Layer – elastomeric substance (26)
Confusion Layer or Second Identification Portion (34)
Removable Opaque or Release Layer (24) – elastomeric substance
Varnish (22)
Indica or First Identification Portion (20)
Non-similar Permanent Confusion (optional) (32)
Substrate Layer (12)

In the present invention (as now shown by amended claim 1), the following layer arrangement below is provided:

Uniquely variable fingerprint Layer (optional) (24)
Removable Layer – not elastomeric (22)
Confusion Layer or Second Identification Portion (21)
Indica or First Identification Portion (8)
Substrate Layer (6)

It can be immediately seen that the layer arrangement in the present invention provides a significantly more secure identification device for the location of confidential indicia or first identification portion thereon.

In Behm, it does mention the provision of a permanent confusion pattern below the indicia **IN ADDITION** to the removable confusion pattern above the indicia (i.e., Behm does not envisage use of a removable confusion pattern in direct contact above the indicia on its own as in the present invention). The purpose of the permanent confusion pattern in Behm is to prevent visualisation of indicia as a result of light being shone underneath the ticket. This confusion pattern is not really a confusion pattern because, since it is permanent, it would permanently confuse visualisation of the indicia when viewed from above. As such, a user must be able to clearly distinguish the indicia on the ticket from the lower confusion pattern when viewing the same from above and therefore it cannot be a true confusion pattern. It is generally found that such “confusion patterns” provided below indicia are a block of colour for example and would not include text, image or characters as in the present invention. The lower confusion pattern is provided purely as light blocking means to block out the indicia altogether when a light is shone from below and is not being to prevent “decipherance” of the indicia when viewed from above as a confusion pattern provided above the indicia is designed to do when viewed from above. The confusion pattern below the indicia is permanent and not removable and there is no teaching to this layer being used on its own. The reason Behm has to provide the second confusion pattern below the indicia is that the first confusion pattern is too far away from the indicia (i.e., separated by a number of intermediate layers) to prevent fraudsters from viewing the indicia on its own.

The present invention overcomes the above disadvantages by providing the confusion pattern or removable second identification portion directly above the first identification portion and below a further removable coating. As such, fewer layers of material are required in the present invention in providing a more secure anti-fraudulent device, thereby making the device of the present invention easier and less expensive to produce. Furthermore, in providing fewer layers of material, and particularly in providing the two identification layers of similar material (1

removable, 1 non-removable) directly adjacent to each other, this allows the material layers of the present invention to be laid down substantially simultaneously, thereby removing or at least reducing the exposure of the indicia or first identification portion to people at the manufacturing site, thereby further enhancing the security of the device. In Behm, since there are so many layers of different material to be laid down, particularly between the indicia layer and the confusion layer, the different layers will have to be laid down separately in production, thereby exposing the indicia to people at the manufacturing site which is not as secure.

Claims 2-15, 18, 20 and 22 each recite combinations of features of independent claim 1, and hence claims 2-15, 18, 20 and 22 are patentable over Downes in view of Behm for at least the above-stated reasons that claim 1 is patentable over Downes in view of Behm.

Claim 24 recites the combinations of features of independent claim 23, and hence claim 24 is patentable over Downes in view of Behm for at least the above-stated reasons that claim 23 is patentable over Downes in view of Behm.

For at least the reasons above, Applicant respectfully asserts that there are numerous claim limitations not taught or suggested in Downes in view of Behm, and thus the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1-15, 18, 20, 22, 23 and 24. M.P.E.P. §2143.

B. Claims 16-17, 19 and 21 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Downes in view of Behm and in further view of Raymond, Thompson and Pistro.

Claims 16-17, 19 and 21 each recite combinations of features of independent claim 1, and hence claims 16-17, 19 and 21 are patentable over Downes in view of Behm and in further view of Raymond, Thompson and Pistro for at least the above-stated reasons that claim 1 is patentable over Downes in view of Behm.

III. CONCLUSION:

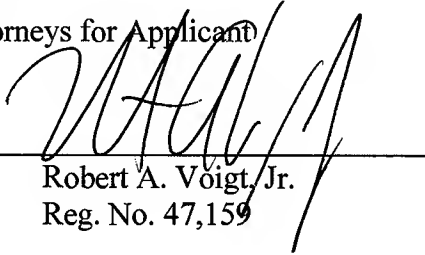
As a result of the foregoing, it is asserted by Applicant that claims 1-24 in the Application are in condition for allowance, and Applicant respectfully requests an allowance of such claims. Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

WINSTEAD P.C.

Attorneys for Applicant

By: _____


Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, Texas 75201
(512)370-2832

Austin_1 533562v.1